

REMARKS – General

Claim Rejections under 35 USC §101:

The OA rejects claims 30-33, 35-36, 39-44, and 61-73 as being directed towards non-statutory subject matter. Specifically, the OA states that claims 30 and 61 recite “computer software components” for manipulating data. The OA cites *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994), as authority for this rejection. The OA submits that a “data structure not claimed as embodied in a computer-readable medium are descriptive material *per se* and are not statutory because they are not capable of causing a functional change in the computer.” *Id.* Applicants respectfully traverse this rejection.

In the Reply filed February 7, 2008, Applicant traversed the rejection. Applicant argued that *Warmerdam* was not applicable to Applicants’ claims. Further, Applicant relied upon MPEP §2106 and Federal Circuit case law been handed down since *Warmerdam*, including *AT&T Corp. v. Excel Communs., Inc.* 172 F.3d 1352 (Fed. Cir. 1999). In that case, the Federal Circuit held that “[t]he Supreme Court has construed § 101 broadly, noting that Congress intended statutory subject matter to “include anything under the sun that is made by man.” *See Diamond v. Chakrabarty*, 447 U.S. 303, 309, (1980); *see also Diamond v. Diehr*, 450 U.S. 175, 182, (1981). “There are only three categories of unpatentable subject matter: “laws of nature, natural phenomena, and abstract ideas.” *See Diehr*, 450 U.S. at 185. “[T]he mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a ‘useful, concrete and tangible result.’” *Diehr*, 450 US at 1374.

In the most recent OA, the rejection under 35 USC §101 is maintained. Applicants reserve the right to reassert the arguments set forth in the February 7, 2008 Reply in this case, should it become necessary. However, in an effort to further prosecution with the Examiner, Applicants have amended herein claims 30-33, 35-36, 39-44 and 61-73 as reciting a system “operable with at least one computer processor” or “operable with a computer,” wherein each component of the system causes the computer

or computer processor to operate in accordance with a particular configuration. Support for the amendment is found in claim 45 as originally filed.

Applicants respectfully submit that, according to MPEP §2106.01, and in accordance with current patent case law, “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, **and is thus statutory.**” *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Emphasis added.

As each of these claims now recites a computer readable medium encoded with computer elements, Applicants respectfully submit that the rejection is overcome. Applicants respectfully request reconsideration of the rejection in light of the amendment and these comments.

Claim Rejections under 35 USC §103:

The most recent Office Action (OA) maintains a rejection to claims 1-33, 35, 36, 39-51, 55, 56, 58, and 60-73 under 35 USC §103 as being unpatentable over Tso et al., US Pat. No. 6,088,803, hereinafter “Tso”, in view of Subramaniam et al., US Pat. No. 6,640,302, hereinafter “Sub,” further in view of Jamtgaard et al., US Pat. No. 6,430,624, herein after “Jam.” (Note that the OA lists Jam as having No. 6,430,324. However, Applicants presume that the number is 6,430,624, and respond accordingly.) Applicants respectfully traverse this rejection.

In the Reply filed February 7, 2008, Applicants respectfully traversed the rejection, arguing that the combination of Tso, Sub, and Jam fails to teach all of Applicants’ claimed limitations. Further, Applicants argued that the combination teaches away from Applicants claimed invention. Specifically, Applicants argued none of Tso, Sub, or Jam teaches determining whether the pre-provisioned content is stored locally or with a trusted third party host, and where the pre-provisioned content is stored with the trusted third party host, retrieving the pre-provisioned content from the trusted third party host and delivering it without additional provisioning.

In the most recent OA, the Examiner noted that the independent claims failed to recite “without additional provisioning.” Applicants have herein amended each of the independent claims to recite just that. Support for the amendment is found at least at Applicants’ paragraph [0092] and FIG. 6.

Next, in the February 7, 2008 response, Applicants argued that Tso fails to teach determining whether the content is stored locally or with a trusted third party host. Indeed, prior Office Actions have stated this very fact. See, e.g., the Office Action of June 25, 2007, page 5. “The combination of Tso-Jiang *does not disclose determining whether the content is stored locally or with a trusted third party host*, and where the pre-provisioned content is stored with the trusted third party host, retrieving the content from the trusted third party host.” Emphasis added.

In the most recent OA, the Examiner noted that the independent claims recite the alternative “or” and thus Applicants’ claims can be read as determining *only* whether the content is stored locally. While Applicants disagree with this assertion, to eliminate confusion and to advance prosecution with the Examiner, Applicants have amended the independent claims to remove the alternative “or locally.” Support for the amendment is found in the independent claims prior to amendment.

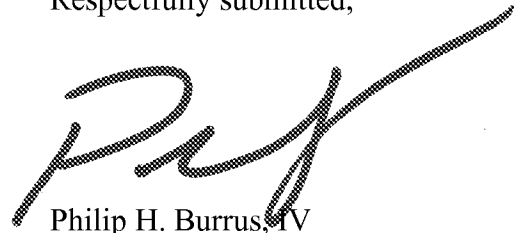
As the only two issues with respect to Applicants’ arguments of February 7, 2008 cited in the most recent OA have been overcome by amendment, Applicants believe the claims to be in condition for allowance. In light of the amendments, Applicants rely upon the arguments set forth in the February 7, 2008 Reply, which are incorporated herein by reference. Applicants respectfully request reconsideration of the rejection.

CONCLUSION

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

For the above reasons, Applicants believe the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Applicants believe this application is now in condition for allowance, for which they respectfully submit. If any matter may be more easily handled by telephone, the undersigned attorney welcomes telephone calls from the Examiner.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Burrus, IV', with a long, sweeping horizontal stroke extending to the right.

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